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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,734	12/16/2003	Gary Daniel Redding	D/A3278Q	3548

25453 7590 08/22/2006

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EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/736,734

Applicant(s)

REDDING, GARY DANIEL

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 20-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 20-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/16/03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Applicant's election **with traverse** of Group I, claims 1-19 in the reply filed on 6 June 2006 is acknowledged. The traversal is on the ground(s) that the examination of both inventions does not represent a serious burden. This is not found persuasive because the searches for the article, and the method of manufacturing the article, are divergent in nature and represent a variance that is significant enough to warrant restriction.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

2. The disclosure is objected to because of the following minor informalities:

The reference to the copending application on page 1 omits the copending application number.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said grooves" in line 5. There is insufficient antecedent basis for this limitation in the claim. There are two sets of grooves previously denoted; lateral grooves and longitudinal grooves. It is unclear as to whether this limitation is directed to the lateral grooves, longitudinal grooves, or both sets of grooves. Since as disclosed in the specification, the dies reside within the lateral grooves, it is presumed that the longitudinal grooves are spaced a distance corresponding to an unspecified and unclaimed die.

Further regarding the terminology, "generally top planar surface", it is unclear as to whether the term "generally" is in reference to the word "top" or "planar". The examiner presumes a generally planar, top surface.

Claims 2-19 are dependent on claim 1 and are rejected for the above reasons.

Further regarding claim 16, the term "high co-efficient of friction" is a relative term which renders the claim indefinite. The term "high co-efficient of friction" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-3 and 5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiFrancesco (US 2001/0033179 A1) in view of Noschese (US 5,305,879).

Claim 1: Insofar as the scope of the claim may be determined, DiFrancesco discloses die holding tray (see Figures 1 & 2) with a rigid base support member **10**, a generally planar top surface (as shown in Figures 2 and 5), a set of lateral grooves **15**, a plurality of strips **16** forming pockets, and vacuum channels **26**. DiFrancesco discloses the claimed invention except for the plurality of longitudinal grooves for receipt of the strips **16**.

Noschese teaches a plurality of longitudinal grooves **38/40** for receipt of strips **42** for the purpose of adjustability of the compartment length. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of DiFrancesco with a plurality of longitudinal grooves as taught by Noschese in order to provide adjustability to the compartment dimensions. It has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

As to the grooves being machined, the method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Claims 2 and 11: DiFrancesco discloses either a one-part or two-part support member (Figure 5 showing both a one-part, the lowermost support member **10**, and two-part, the uppermost support member **10a/10b**).

Claims 3, 5-7, 12-15: All materials claimed by the applicant were known in the art at the time of the invention. Moreover, DiFrancesco suggests a variety of materials (see paragraph [0038]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the items in the claimed materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 8: DiFrancesco discloses an orthogonal interface between the walls and bottom of the pockets (see Figures 2 & 5).

Claim 9: DiFrancesco suggests a metal material (paragraph [0038]) and teaches the sliding of the retained devices within the grooves **15** (paragraph [0039]). It would have been obvious to one of ordinary skill in the art to polish the grooves **15** in order to enable sliding of the retained articles.

Claim 10: Insofar as the dies are not positively claimed, the vacuum channels of DiFrancesco may be considered to be sized as claimed, dependent upon the size and shaped of the undisclosed and unclaimed retained dies.

Claims 16 and 17: DiFrancesco discloses metal (see paragraph [0038]), which has the claimed properties.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiFrancesco-Noschese as applied to claim 1 above, and further in view of Abraham et al (US 5,907,246; hereinafter Abraham).

DiFrancesco-Noschese discloses the claimed invention except for the vacuum channels being wider near the bottom.

Abraham discloses a **312** with a chamfered bottom **330** to enable the use of a pushing device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the vacuum channels of DiFrancesco-Noschese with a chamfered bottom to enable the use of a pushing device. Such a chamfering of the bottom would result in a channel that is wider near the bottom than near the top.

***Allowable Subject Matter***

6. Claims 18 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

It appears that the available prior art neither discloses, nor fairly suggests a two-part tray with the upper part being formed from a rigid inner stage covered by a compliant material, into which the grooves are machined, in combination with the other claimed structures.

8. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Greg Pickett  
Examiner  
19 August 2006